



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,781	07/21/2000	Greg Benson	MEDIDNA.018C1	3981

7590

02/27/2004

Alan H. MacPherson
MacPherson Kwok Chen & Heid LLP
2001 Gateway Place
Suite 195E
San Jose, CA 95110

EXAMINER

DUONG, OANH L

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/620,781

Applicant(s)

BENSON ET AL.

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 12/10/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "authorization for access is outside of the environment or associated rules") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Schneck does not disclose, suggest, or even require that a user action between a first application and a second application be intercepted, wherein the second application creates the digital object. Examiner respectfully disagrees because Schneck does disclose, suggest, or require this feature. For example, Schneck discloses a user action (payment 110) between a first application (Netscape Navigator) and a second application (for example, distributor, producer, publisher, etc.) is intercepted (at authoring mechanism 112) (col. 12 lines 4-9 and col. 22 lines 16-53).

As a result, the cited prior arts do disclose a system and method for intercepting a communication between two applications in a computer environment, as broadly claimed by the applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior arts.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-12, 14, 15 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneck et al (Schneck) (US 6,314,409 B2).

Regarding claim 1, Schneck discloses a method of intercepting a data communication between two applications in a computer environment (e.g., see fig. 15), the method comprising intercepting a user action (payment 110) between a first application (e.g., producer, supplier, distributor, publisher, etc.) and a second application (e.g., user, client, subscriber, access mechanism) without changing a functionality of the first application and second application (e.g., see col. 12 lines col. 30 lines 25-43); and providing a digital object created by the second application (packaged data 108b) (e.g., see col.28 lines 14-18); providing a control object capable of specifying an action on the digital object depending on the intercepted user action (e.g., see fig. 16 col. 15 lines 31-40); and performing the action specified by the control object on the digital object (e.g., see col. 30 lines 42-60 and col. 32 lines 43-53).

Regarding claim 2, Schneck discloses the first and second applications communicate via a predetermined communication channel (e.g., see fig. 15 col. 16 lines 60-61).

Regarding claim 3, Schneck discloses re-directing the user action to a third application (e.g., see col. 9 lines 59-67).

Regarding claim 4, Schneck discloses monitoring user action (e.g., see col. 17 line 65-col. 18 line 3).

Regarding claim 5, Schneck discloses auditing user actions taken on a digital object by recording the type and frequency of the user actions (e.g., see col. 31 lines 1-9).

Regarding claim 7, Schneck discloses augmenting information to the user action (e.g., see col. 39 lines 31-32).

Regarding claim 8, Schneck teaches authorizing user access and use of the digital object (e.g., see col. 6 lines 63-64).

Regarding claim 9, Schneck teaches authorizing user access and use of the application (e.g., see col. 6 lines 63-64).

Regarding claim 10, Schneck discloses activating purchase requirements for user access and use of the digital object (e.g., see col. 30 lines 42-55 and col. 36 lines 37-41).

Regarding claims 11-12, Schneck discloses activating purchase requirements for user access and use of the second application (e.g., see col. 30 lines 42-55 and col. 36 lines 37-41).

Regarding claim 14, Schneck discloses rendering audible or feedback to user actions implemented on the digital object or the second application (e.g., see col. 25 lines 20-44).

Regarding claim 15, Schneck discloses archiving a history of the user actions implemented on the digital object or the second application (e.g., see col. 30 lines 3-7 and col. 31 lines 1-9).

Regarding claim 19, Schneck teaches a method of embedding a control object into a host application as an interface to determine control rights of a digital object (e.g., see abstract), the method comprising providing a digital object created by a document server application in communication with the hosting application (e.g., see col. 9 lines 9 lines 59-64); providing a control object to open the digital object and to read control rights associated with the digital object (e.g., see col. 10 lines 1-5); intercepting a user action (payment) between the hosting application (e.g., Netscape Navigator) and the document server application (e.g., producer, distributor, publisher) by an intercept application (e.g., see fig. 15 see col. 22 lines 16-53 and col. 30 lines 25-43) ; monitoring the user action intercepted by the intercept application (e.g., see col. 17 line 45-col. 18 line 3); and authorizing a user to implement an action on the digital object depending on the intercepted user action and according to the control rights (e.g., see col. 24 lines 52-65 and col. 39 line 47-col. 40 line 4).

Regarding claim 20, Schneck teaches the hosting application comprises an Internet browser application (e.g., see col. 22 lines 32-53).

Regarding claim 21, Schneck teaches a system of embedding a control object into a hosting application as an interface to determine the control rights of a digital object and to monitor user actions (e.g., see abstract); the system comprising a control object which monitors a plurality of user actions (e.g., see col. 17 line 45-col. 18 line 3 and col. 24 lines 52-65); hosting application which activates the control object to open a digital object and to read control rights associated with the digital object (e.g., see col. 10 lines 1-5); a document server application associated with creation of the digital object (e.g.,

Art Unit: 2155

see col. 9 lines 9 lines 59-64); and an intercept application which intercepts the user actions (payment) between the hosting application (e.g., Netscape Navigator) and the document server application (e.g., producer, distributor, publisher) (e.g., see fig. 15 col. 22 lines 16-53 and col. 30 lines 25-43).

Regarding claim 31, Schneck teaches an edit on the digital object (e.g., see col. 33 line 50-col. 34 line 8).

Regarding claim 32, Schneck teaches an edit on the digital object (e.g., see col. 33 line 50-col. 34 line 8).

Regarding claim 33, Schneck teaches an edit on the digital object (e.g., see col. 33 line 50-col. 34 line 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck in view of Rosborough et al (Rosborough) (US 6,493,754 B1).

Regarding claim 6, Schneck does not teach monitoring action as claimed. However, Rosborough teaches monitoring comprises computing efficiency of the first application or the second application for performance certain user actions (see col. 4

Art Unit: 2155

lines 48-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combined monitoring action in Schneck as taught by Rosbrought because such monitoring action enables the system to measure the response time for transaction or application and statistical analysis can be performed on the response times to facilitate analysis of network devices and network performance. This is useful performance monitoring, billing and monitoring of service level agreement compliance (Rosborough, e.g., see col. 4 lines 61-63).

4. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck in view of Ramstrom (US 5,960,004).

Regarding claims 13 and 16, Schneck does not teach helping program as claimed. However, Ramstrom teaches executing help program on specific application communications (see col. 11 lines 32-42). Therefore, it would have been obvious to have used the help program in Schneck as taught by Ramstrom because it would assist users in making efficient use of the facilities which are available.

5. Claims 17, 18, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck in view of Knapton, III (Knapton) (US 6,363,486 B1).

Regarding claims 17 and 22, Scheck teaches providing an intercept application which intercept user an editing user actions (payment) sent from the hosting application (Netscape Navigator) to a host application (e.g., owner, publisher, distributor, etc.,) (e.g., see fig. 15 col. 22 lines 16-53 and col. 30 lines 25-43); providing an external

Art Unit: 2155

control agent which monitor the user actions intercepted by the intercept application (e.g., see col. 17 line 65-col. 18 line 3 and col. 24 lines 52-65); activating the external control agent to open the digital object and to read the rules that are associated with the digital object (e.g., see col. 20 line 49-col. 21 line 19); sending user action from intercept application to the external control agent whereby the user action is monitored by the external control agent (e.g., see col. 17 line 45-col. 18 lines 3, col. 18 lines 14-17 and col. 24 lines 52); opening the digital object by using the intercept application (e.g., see col. 20 line 49-col. 21 lines 19); performing the user action on the digital object according to the rules of usage (e.g., see col. 15 lines 31-35). Schneck does not explicitly teach registering the application with an operating system. However, Knapton teaches registering the application with an operating system (see col. 1 lines 23-42 and cols. 3-4 lines 59-1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine an application registration with an operation system in Schneck as taught by Knapton because such an application registration would enables the operating system to store only authorized components in the registry. This eliminates unauthorized use of a developer's software (Knapton, e.g., see col.2 lines 15-16).

Regarding claims 18 and 23, Schneck discloses the hosting application comprises an Internet browser application (e.g., see col. 33 lines 17-29).

Art Unit: 2155

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



FRANTZ B. JEAN
PRIMARY EXAMINER

O.D
February 23, 2004